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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/751,742

Filing Date: January 05, 2004

Appellant(s): AU ET AL.

Scott D. Paul
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 6, 2008 appealing from the Office action mailed September 6, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2006/0218052	Haynes et al.	09-2006
2003/0033218	Flaxer et al.	02-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-9, 12-15, and 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Haynes (US 2006/0218052).

Referring to claim 1. Haynes discloses a method of creating a marketplace with hosted supplier stores comprising the steps of:

- Providing tools for creating and managing a hosted supplier store to each of a plurality of suppliers through a commerce site, said tools including a catalog facility for uploading and managing a supplier catalog for said hosted supplier store (Haynes: abstract and figure 1);
- Receiving a plurality of supplier catalogs from said plurality of suppliers (Haynes: paragraph 18);
- Aggregating said plurality of supplier catalogs into an aggregated catalog (Haynes: paragraph 18 disclosing a supplier adding items from its catalog to a searchable database to allow a buyer to search the catalog of items stored in the database); and
- Providing a buyer with access to said aggregated catalog and separate access to at least one of said plurality of supplier catalogs on said commerce site (Haynes: paragraphs 17-18 and paragraph 47). See at least, "Such an interface permits a buyer to search a catalogue of products and/or services of a particular supplier."

Referring to claim 2. Haynes further discloses a method including:

- Providing a supplier hub catalog topology (Haynes: figure 1 and paragraph 89 disclosing defining product relationships); and
- Wherein said step of aggregating includes aggregating said supplier catalogs according to said supplier hub catalog topology (Haynes: paragraph 89).

Referring to claim 3. Haynes further discloses a method wherein:

- Said supplier catalogs include shared marketplace products and supplier specific products (Haynes: paragraphs 89-90);

- Said buyer access said aggregated catalog through one of said hosted supplier stores owned by one of said suppliers (Haynes: figure 4 and paragraph 48 disclosing the buyer accessing the catalog through a vendor site); and
- Said step of aggregating includes aggregating said shared marketplace products from all of said suppliers with said supplier specific products from said one of said suppliers (Haynes: abstract, figure 5 showing the supplier catalog editing process and paragraph 18).

Referring to claim 6. Haynes further discloses a method including the steps of:

- Providing said buyer with trading mechanisms for generating orders for items within said aggregated catalog (Haynes: paragraph 48);
- Developing requests for quotations for made-to-order items (Haynes: paragraph 58-59 disclosing request for proposal for custom products); and
- Negotiating contracts between said suppliers and said buyers (Haynes: paragraph 113). The examiner notes that an agreement is the same as a contract between suppliers and buyers.

Referring to claims 7-9,12-15, and 18-19. Claims 7-9, 12-15, and 18-19 are rejected under the same rationale set forth above. Hayes discloses systems and mediums containing instructions with limitations similar to those cited in the rejection of claims 1-3 and 6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5, 10-11, 16-17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haynes (US 2006/0218052) in view of Flaxer (US 2003/0033218)

Referring to claims 4-5. Haynes discloses all of the above as noted under the 102(e) rejection but does not expressly disclose a method including entitlement information for buyers including pricing. Flaxer discloses a method for defining customizable subsets of a catalog including:

- Receiving contract data from one of said suppliers, said contract data including entitlement information for said buyer in relation to a product (Flaxer: abstract and paragraph 8); and
- Wherein the step of providing said buyer with access includes filtering said aggregated catalog based upon said entitlement information (Flaxer: paragraph 8).
- Receiving a buyer request for said product (Flaxer: abstract); and
- Wherein said step of filtering includes identifying hosted supplier stores offering said product, identifying eligible contracts within said identified hosted supplier stores, retrieving entitlement information from said eligible contracts, and

applying said retrieved entitlement information, wherein said entitlement information includes pricing (Flaxer: paragraph 8).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Haynes to have included entitlement information for buyers including pricing, as taught by Flaxer, in order to allow for personalized pricing by the vendor to maximize profit (Flaxer: abstract).

Referring to claims 10-11,16-17, and 20. Claims 10-11,16-17, and 20 are rejected under the same rationale set forth above. The combination of Haynes and Flaxer discloses systems and mediums containing instructions with limitations similar to those cited in the rejection of claims 4-5.

(10) Response to Argument

Appellant's arguments filed February 6, 2008 have been fully considered but they are not persuasive.

The examiner disagrees with appellant's assertion that burden of initial examination has not been met due to insufficient indication of the relevant disclosure of the prior art. The examiner believes that the specific passages cited above in the 35 USC 102 rejection to Haynes (US 2006/0218052) clearly articulate the relevant disclosure. The cited passages of Haynes are in no way verbose or overly long and it is not necessary to reprint a line by line disclosure of the prior art in the rejection, as the prior art is readily available. Furthermore, it is unclear which position appellant is taking in their argument; a comparison of the claim limitations against specific passages and

areas of disclosure from the pertinent prior art has been provided, yet appellant also argues that the rejection merely consists of repetition of the claim language being "disclosed by certain specified passages within Haynes". Lastly, as each and every limitation has been compared against a specific disclosure of the reference, it is clear that each claimed feature has been considered and analysis of the identical features has been performed.

For example, appellant argues that citation of paragraph 18 is insufficient to show that Haynes anticipates the limitations:

"receiving a plurality of supplier catalogs from said plurality of suppliers;" and aggregating said plurality of supplier catalogs into an aggregated catalog."

The examiner submits that the above limitations are clearly disclosed as noted in paragraph 18:

In another aspect of this invention, there is described a method of **constructing a searchable database that stores at least one catalogue of items that may be bought by at least one buyer and are supplied by at least one supplier** (receiving and aggregating suppliers' catalog).

Reference is also made to paragraph 22 of Haynes disclosing storing specific catalogs for each supplier of plurality of suppliers on a database structure (see also figure 1). The cited passages of the prior art in the rejection not intended to be limiting, the reference as a whole must be considered.

Furthermore, the examiner submits that terms within the claims are given their meanings based upon the appellant's specification or when they are not defined within

the specification, their broadest reasonable meaning. See at least MPEP 904.01

Analysis of Claims.

904.01 Analysis of Claims

The breadth of the claims in the application should always be carefully noted; that is, the examiner should be fully aware of what the claims do *not* call for, as well as what they do require. During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). See MPEP § 2111 - § 2116.01 for case law pertinent to claim analysis.

The examiner submits that a *prima facie* case of anticipation has been made by the Office by an explicit explanation of the rejection and the Appellant has not responded with arguments that comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The appellant further alleges on page 11 of the brief that the Examiner is relying upon an inherency argument. This is incorrect as specific passages of the prior art have been cited in making a proper 35 USC 102(e) rejection. Lastly, the Examiner notes that Appellant is attempting to confuse the primary issue at hand (if Haynes properly anticipates the recited claim limitations) by rearranging similar arguments directed at whether claim interpretation has occurred. Claim examination was performed as evidenced by the rejection above.

Appellant argues in the last paragraph of page 13 of the brief that a catalog is defined as "a list of items that are accessible by a user, as a list". No such definition is

present in appellant's specification. Haynes defines a searchable database as a catalog accessible by users consisting of supplier items (see at least paragraph 18). The examiner submits that by not defining catalog in appellant's specification, a determination of the broadest reasonable meaning of the term was made and the searchable database of Haynes discloses the catalog of claim 1. Once again, the appellant is confusing the issue at hand by not addressing the fact that Haynes discloses each supplier supplying their own catalog and a buyer being entitled to search the entire database. Appellants' analogy to a claimed bicycle with two wheels yet no disclosure of the wheels in the specification is a misplaced comparison to the current application. If a claim recited a bicycle in passing then the Examiner agrees it would not be necessary to explicitly disclose the bicycle containing two wheels, however if the claim was directed at a bicycle with a new hub system between the fork and wheel then it would be necessary to disclose what kind or type of wheel was being used in the application. The examiner submits that the recited limitation of a catalog in claim 1 cannot distinguish from the catalog of Haynes as Appellant has not provided a clear definition for a catalog and therefore one of ordinary skill in the art would reasonably define it as a searchable database of items (see at least the abstract of Haynes). Lastly, Appellant refers to a "single catalog of times (sic) stored in the database" on page 15 of the brief as evidence that paragraph 18 of Haynes does not refer to a plurality of catalogs. The examiner disagrees as Haynes is setting forth an example of how the method works for one supplier while the embodiments clearly indicate the

method is applicable to multiple suppliers (figure 1 disclosing vendor users). The same rationale is applied to Appellant's arguments regarding claim 2.

The examiner further disagrees with appellant's contention that Haynes does not teach a buyer accessing said aggregated catalog hosted supplier stores owned by said suppliers. Figure 1 and paragraph 48 of Haynes disclose vendor and supplier sites. Appellant's specification does not specifically define "stores" and "owned" and as such the terms are given their broadest reasonable meanings. It is well known within the art that supplier "stores" are web sites and since the sites (22b) are defined as "vendor sites" ownership is indicated. Appellant concedes that the vendor site 22b could be owned by one of the suppliers and the Examiner submits that perhaps the confusion in Appellant's argument is due because Appellant is mistakenly referencing paragraph 47 (as reproduced in the brief) as paragraph 48.

Regarding Appellant's argument to claim 6 and "made-to-order" on pages 17-18 of the brief, please note paragraph 58 of Haynes disclosing a buyer making request for proposal for custom (i.e. made-to-order) products.

Dependent claims 4-5, 10-11, 16-17, and 20 (rejected under 35 USC 103 as being unpatentable over Haynes in view of Flaxer are further rejected under the same rationale as the independent claims they depend upon.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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